

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC J. BACULY

Appeal No. 1999-1758
Application 08/787,971

ON BRIEF

Before ABRAMS, FRANKFORT, and PATE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8, 10 and 24. Claims 9, 12-20, 25 and 26 are withdrawn from consideration as being drawn to a non-

Appeal No. 1999-1758
Application No. 08/787,971

elected invention. Claims 11 and 21-23 have been canceled.

Appellant's invention relates to an adaptor (22, 76) for a beam or bar clamp assembly (10, 70). The adaptor (22, 76) is for allowing a plurality of clamping fixtures (42, 43, 83, 84, 103, 104, 200, 202) to be interchangeably mounted using a connector (34, 79) and a fastener bolt (53) to a plurality of beam and bar clamp assemblies (10, 70) shown in Figures 1 and 7. The adaptor (22) includes fastener clips (24) with tightening screws (36) for releasably engaging and gripping a jaw (14) of a beam/bar clamp (10, 70) and a protective ledge (38) for preventing the work piece from contacting the beam or bar (12, 14) of the clamp assembly. A representative copy reproduced from appellant's brief of independent claims 1 and 24 is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness are:

Periolat	1,498,638	Jun. 24, 1924
Durfee, Jr.	4,923,186	May 8, 1990
Nishimura	4,953,840	Sep. 4,

Appeal No. 1999-1758
Application No. 08/787,971

as being unpatentable over Durfee in view of Nimtz and Periolat.

Claims 5-7 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Durfee in view of Nimtz and Periolat as applied to claims 1-4, 8 and 10 above, and further in view of Nishimura.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the final rejection (Paper No. 11, mailed February 4, 1998) and the examiner's answer (Paper No. 16, mailed December 8, 1998) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 15, received October 13, 1998) and appellant's reply brief (Paper No. 17, received February 17, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given

Appeal No. 1999-1758
Application No. 08/787,971

careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner.

We turn first to the examiner's rejection of appealed claims 1-8 and 10 under 35 U.S.C. § 112, first paragraph, which rejection we understand to be based upon the written description requirement of the first paragraph of § 112. In general, the test for determining compliance with the written description requirement of § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language under consideration. Further, it is also well settled that the content of the drawings may be considered in determining compliance with the written description requirement. See Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993); Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555,

Appeal No. 1999-1758
Application No. 08/787,971

1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991); see also In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Appellant sets forth (brief, page 4) that the claim language that defines the adaptor as "configured to releasably engage and grip at least two adjacent or two opposing surfaces of a jaw of a beam clamp," which was added to claim 1, lines 3-4 in Paper No. 7, finds support on page 6, lines 16-20 and is shown in Figures 1 and 7 of the application which show how the adaptors engage both adjacent and opposing surfaces of jaws of a beam clamp. In the office action subsequent to Paper No. 7, the examiner's response, Paper No. 11, page 4, lines 8-11, was that "such language is not herein found . . . or defined in the descriptive portion of the specification." Appellant further argues in the Brief, pages 4-7, that if the adaptor is configured to "engage and grip a vertical flange portion 30 of jaws 14 and 16" (as set forth at page 6, lines 16-20 of the original specification), the adaptor must necessarily "engage and grip at least two adjacent or opposing surfaces of a jaw

of a beam clamp" as set forth in amended claim 1. The examiner responded to this argument in the answer, page 6, by pointing out that the angular clips (24, 77) in the embodiments shown in the Figures 1 and 7 "only engage the vertical rear edge of flange 30 and appears to be incapable of engaging any flange surface whatsoever." Appellant responded (reply brief, pages 1-2) with the argument that the claim language requires that the "adaptor" and not only the clips (24, 77) be "configured to releasably engage and grip at least two adjacent or two opposing surfaces of a jaw of a beam clamp." Appellant further points out that the rear wall (28) of the adaptor engages only the face of the jaw (14) and then alleges that clips (24) engage "the edges (i.e., adjacent surfaces) and/or rear surfaces (i.e., surfaces opposite the face of the jaw) of the jaw."

We understand from the specification, page 6, line 16-32 and drawings Figures 1 and 7, that the angled fastener clips (24, 77) are angled starting at the rear edge of the block (26) and are adjustably fastened to the block (26) with screws

(36) to adjust the securing force of the clips (24, 77) to the vertical flange portion (30) of jaws (14, 16). As is apparent from Figures 1, 4-7 and 12 of the application drawings, in order to be able to adjust the securing force of the clips (24, 77), the angled face of the clips (24, 77) are in contact with the rear vertical edge of the jaws (14, 16). Thus, we agree with the examiner that the clips (24, 77) contact a rear vertical edge of the flange portion (30) and do not contact a surface of the jaws (14, 16). Accordingly, the adaptor (22) only contacts a single surface of the vertical flange portion (30) of the jaw and therefore we conclude that an adaptor configured to releasably engage and grip "at least two adjacent or two opposing surfaces of a jaw of a beam clamp" is not disclosed in the instant application.

With respect to appellant's arguments on page 5 of the Brief, that the above rejection under section 112, first paragraph, is both procedurally and substantively improper, appellant argues that upon informing the examiner in Paper No.7 of the location for support of the matter added to claim

1, the examiner did not meet his initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention described in the claims. Upon reviewing the Office actions subsequent to the amendment of Paper No. 7 (the final rejection, Paper No. 11 and the examiner's answer, Paper No. 16), we do not agree with appellant's assertion of impropriety. The examiner provided evidence and reasoning in Paper No. 11, pages 2 and 4, and expanded the explanation of the evidence and reasoning in the examiner's answer on page 6. The evidence and reasoning provided by the examiner and not disputed by appellant included the fact that the terms "two adjacent surfaces" and "two opposing surfaces" are not defined in the specification and that the angular clips (24) are shown in the drawings as only engaging a vertical edge of the flange (30) and not a surface of the flange. Even though the examiner may not have articulated his position clearly enough for appellant to understand, upon review of Papers No. 11 and 16, we note that the examiner did provide evidence and reasoning as to why one of ordinary skill in the art would not recognize in the originally filed disclosure a description of

Appeal No. 1999-1758
Application No. 08/787,971

the invention now set forth in claims 1-8 and 10 on appeal. Accordingly, we conclude that the rejection under section 112, first paragraph, is procedurally and substantively proper.

With respect to appellant's argument on the bottom of page 6 of the brief, appellant argues that original claim 5 includes the language "first and second fastening clips which are secured to the adaptor, the clips being configured to engage opposite sides of a jaw of a beam clamp assembly" gives basis from the original disclosure for the phrase "adaptor configured to releasably engage and grip at least two adjacent or two opposing surfaces of a jaw" set forth in claim 1. Upon reviewing of claim 1 on appeal and original claim 5, we note that claim 5 refers to "opposite sides of a jaw" and that claim 1 refers to "at least two adjacent or two opposing surfaces of a jaw." Since the "opposite sides" language of claim 5 is clearly different from the "two adjacent or two opposing surfaces" language of claim 1 and is also somewhat ambiguous, we conclude that the structure defined in original claim 5 is not sufficient to reasonably convey to one skilled in the relevant art that the inventor, at the time the

Appeal No. 1999-1758
Application No. 08/787,971

application was filed, had possession of the claimed invention as defined in claim 1 on appeal.

Accordingly, we will sustain the examiner's rejection of claims 1-8 and 10 under 35 U.S.C. § 112, first paragraph.

Now we look to the rejection of claims 1-8 and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. Specifically, claim 1 includes the recitation "an adaptor configured to releasably engage and grip at least two adjacent or two opposing surfaces of a jaw of a beam clamp." The examiner contends (answer, page 6) that there is no clear description in the instant specification defining what is being claimed and no reference characters in the drawings to designate the adjacent or opposing surfaces as set forth in claim 1 on appeal. The examiner further contends that the angular clips 24 of appellant's invention in fact engage no surfaces of the jaw (14, 16). We agree with the appellant (Reply Brief, page 3) that the exact wording of the claims is

Appeal No. 1999-1758
Application No. 08/787,971

not required to be part of the specification. However, the question under 35 U.S.C. § 112, second paragraph is whether those having ordinary skill in the art are capable of ascertaining the metes and bounds of the claimed subject matter. Ascertaining the metes and bounds of the claims, one of ordinary skill in the art has to ascertain the meaning of the claim language in light of the specification. Therefore the subject matter, i.e., structure, set forth in the claims has to be ascertainable from subject matter disclosed in the specification.

With this as our basis, we look to the specification to ascertain what structure is being referred to by the phrase "configured to releasably engage and grip at least two adjacent or two opposing surfaces of a jaw of a beam clamp." Appellant sets forth (reply brief, page 3) that one surface of the jaw is engaged by the rear wall (28) of the adaptor (22) and that the angular clips (24) engage a vertical rear edge of the vertical flange portion (30) of the jaw. According to the appellant (reply brief, page 3), since the angular clip (24) engages a vertical rear edge of the jaw then the clip (24)

Appeal No. 1999-1758
Application No. 08/787,971

engages a surface of the jaw, and that surface may be considered to be opposite, adjacent or both to the face of the jaw (14) which is engaged by the rear surface (28) of the adaptor (22). As set forth above under the section 112, first paragraph rejection, we understand each angular clip (24) to engage a rear edge of the vertical flange portion (30) of the jaw and not a surface of the jaw. In contrast to appellant's position, we note that the edge or corner of the vertical flange portion (30) is a line where two surfaces meet and is not a surface. Thus, contrary to the appellant's assertions in the reply brief, the edge or corner may not be considered a surface opposite, adjacent or both to the face of the jaw of flange (30). Therefore, we conclude that the specification does not disclose the subject matter set forth in claim 1, lines 3-4 and that the claim language on its face is not understandable, because we do not understand what surfaces of the jaw are being defined. Accordingly, we will sustain the rejection by the examiner of claims 1-8 and 10, under 35 U.S.C. § 112, second paragraph.

Appeal No. 1999-1758
Application No. 08/787,971

In regards to the rejection of claims 1-4, 8 and 10 under 35 U.S.C. § 103 as being obvious over Durfee in view of Nimtz and Periolat and the rejection of claims 5-7 under 35 U.S.C. § 103 as being obvious over Durfee in view of Nimtz and Periolat and further in view of Nishimura. We emphasis again that these claims contain unclear language which renders the subject matter thereof indefinite for reasons stated supra as part of the rejection of claims 1-8 and 10 under 35 U.S.C. § 112, second paragraph. Accordingly, we find that it is not possible to apply the prior art relied upon by the examiner to these claims in deciding the question of obviousness under 35 U.S.C. § 103 without resorting to considerable speculation and conjecture as to the meaning of the questioned configuration to releasably engage and grip at least two adjacent or two opposing surfaces of a jaw of a beam clamp in the claims. This being the case, we are constrained to reverse the examiner's rejection of claims 1-4, 8 and 10 under 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). We hasten to add that this reversal of the examiner's rejection is not

Appeal No. 1999-1758
Application No. 08/787,971

based on the merits of the rejection, but on technical grounds relating to the indefiniteness of the appealed claims. Accordingly, we will not sustain the examiner's rejection of claims 1-8 and 10 under 35 U.S.C. § 103.

The last rejection for our consideration is that of independent claim 24 under 35 U.S.C. § 103 as being obvious over Durfee in view of Nimtz, Periolat and Nishimura. In reviewing the examiner's rejection, on pages 4 and 5 of the answer, the examiner is of the view that Durfee shows a clamp having a detachable jaw (adapter bloc) which includes a protective ledge 21 (Figure 1 of Durfee). The examiner views Nimtz as teaching a beam clamp (10) having protective ledges (26, 28); Periolat as teaching a threaded bore in a jaw to receive releasable work piece clamping fixtures; and Nishimura as teaching an adjustable clip assembly (10) to attach an adapter block to a jaw with a threaded fastener (9).

With respect to appellant's arguments on pages 12-13 and 15 of the brief, we agree with appellant in that the teachings of Durfee, Nimtz, Periolat and Nishimura are from diverse art

areas and that combination of the references is questionable at best. Moreover, even if the combination proposed by the examiner were to be deemed proper, we agree with appellant's argument (brief, pages 11 and 13-15) that the combination of Durfee, Nimtz, Periolat and Nishimura fails to teach an adaptor configured to be secured to the jaw of a beam clamp assembly, having a work piece engaging surface with a protective ledge extending integrally therefrom and having a connector for releasably attaching a work piece clamping fixture to the adaptor as set forth in claim 24. Upon reviewing Durfee, we note that Durfee includes an adapter block or plate (20) with a connector (41, 36) for releasably attaching a work piece clamping fixture (21) to the work piece engaging surface (25) of the block or plate (20). Contrary to the examiner's position, the adaptor of Durfee does not also include "a protective ledge which extends integrally from the workpiece engaging surface" as required in appellant's claim 24 on appeal. If the structure (21, 41, 36) of Durfee were to be read as being a "protective ledge which extends integrally from the work piece engaging surface of the adaptor block" as in appellant's claim 24, then the adaptor of Durfee would have

Appeal No. 1999-1758
Application No. 08/787,971

no "connector on the adaptor block for releasably attaching a workpiece changing fixtures to the adaptor block," as required in claim 24. Accordingly, we agree with the appellant (brief, pages 13-14) that even though both Durfee and Nimtz disclose protective ledges, neither reference discloses a protective ledge which extends integrally from the work piece engaging surface of the adaptor block, (emphasis added) and a connector for releasably attaching a work piece clamping fixture. In light of the foregoing, we cannot sustain the examiner's rejection of claim 24 under 35 U.S.C. § 103.

CONCLUSION

In summary, the examiner's decision to reject claims 1-8 and 10 under 35 U.S.C. § 112, first paragraph and second paragraph, has been affirmed and the examiner's decision to reject claims 1-8, 10 and 24 under 35 U.S.C. § 103 has been reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Appeal No. 1999-1758
Application No. 08/787,971

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
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Appeal No. 1999-1758
Application No. 08/787,971

CLAIM 1

1. An adaptor for interchangeably connecting any of a plurality of clamping fixtures to a beam clamp assembly, comprising:

an adaptor configured to releasably engage and grip at least two adjacent or two opposing surfaces of a jaw of a beam clamp and;

Appeal No. 1999-1758
Application No. 08/787,971

a connector on the adaptor for translationally fixing and releasably attaching a workpiece clamping fixture to the adaptor.

CLAIM 24

24. An adaptor for interchangeably connecting any of a plurality of clamping fixtures to a beam clamp assembly, comprising:

an adaptor block;

a fastener attached to the adaptor block for releasably securing the adaptor block to a jaw of a beam clamp assembly;

a connector on the adaptor block for releasably attaching a workpiece clamping fixture to the adaptor block;

the adaptor block including a workpiece-engaging surface which faces toward an opposing second jaw of a beam clamp assembly when the adaptor is secured to a first jaw of the beam clamp assembly; and

a protective ledge which extends integrally from the workpiece-engaging surface so that it is disposed adjacent to a beam of a beam clamp assembly when the adaptor is mounted on the beam clamp assembly, whereby the ledge is interposed between a workpiece and the beam when a workpiece is engaged by the workpiece-engaging surface of the adaptor mounted a jaw of the beam clamp assembly, and whereby contact between the workpiece and the beam is avoided.

Appeal No. 1999-1758
Application No. 08/787,971